

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed on July 13, 2006. At the time of the Office Action, Claims 1-8 and 10-28 were pending and 17-28 were withdrawn. The Examiner rejects Claims 1-8 and 10-16. As described below, Applicant believes all claims to be allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and full allowance of all pending claims.

Double Patenting

The Examiner provisionally rejects Claims 1-16 under the judicially created doctrine of obviousness-type double patenting. Specifically, Claims 1-8 and 10-16 are rejected as being unpatentable over Claim 1 of copending Application No. 09/817,353 (“353 Application”) in view of U.S. Patent Application Publication No. 2002/0010634 A1 issued to Roman et al. (“*Roman*”) and U.S. Patent Application Publication No. 2001/0032143 A1 issued to Haseltine (“*Haseltine*”). Applicant stands willing to file a Terminal Disclaimer with respect to these claims in their current form upon indication of their allowability.

Section 103 Rejections

The Examiner rejects Claims 1-8 and 10-16 under 35 U.S.C. 103(a) as being unpatentable over *Roman* in view of *Haseltine*. In the previous Response to Office Action submitted on April 26, 2006, Applicant made two arguments with respect to Applicant’s claims and the proposed *Roman-Haseltine* combination. First, Applicant argued that the proposed *Roman-Haseltine* combination fails to disclose, teach, or suggest each and every feature of Applicant’s claims. Second, Applicant demonstrated that the proposed *Roman-Haseltine* combination is improper because one of ordinary skill in the art would not have been motivated at the time of Applicant’s invention to make the proposed combination. Because Applicant continues to believe that these arguments have merit, Applicant reiterates and expands those arguments now.

The Claims are Allowable over the proposed *Roman-Haseltine* Combination

In the Previous Response to Office Action, it was Applicant's position that the proposed *Roman-Haseltine* combination does not disclose teach or suggest at least the following features and operations recited in amended Claim 1:

- displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise [having been purchased by the customer in a prior purchase transaction]; and
- receiving a selection of an item of merchandise from the list from the customer via the web access tool.

In the Final Office Action, the rejection of Claim 1 is maintained by the Examiner using proposed *Roman-Haseltine* combination. However, Applicant continues to submit that neither *Roman* nor *Haseltine* (whether considered alone or in combination) disclose, teach, or suggest the above recited elements.

In the Final Office Action, the Examiner continues to cite *Roman*, specifically, for disclosure of "displaying to the customer, here the consumer, return information at the web access tool (pp 0019 "the system provides instructions for return shipping")." (Final Office Action, page 3). The Examiner also cites *Roman* for disclosure of "receiving return-related data from the customer, via the web access tool (pp0015 clickreturns.com receives information from customer regarding receipt number etc.), thereby identifying a return item." (Final Office Action, page 3). Applicant respectfully notes, however, that even if *Roman* discloses displaying return information and receiving return-related data from the consumer, as suggested by the Examiner (and to which Applicant does not admit), *Roman* cannot be said to disclose, teach, or suggest "displaying, to the customer via the web access tool, **the transaction information comprising a list of the at least one item of merchandise**" and "receiving a selection **of an item of merchandise** from the list," as recited in Claim 1 as amended in the Response to Office Action submitted on April 26, 2006.

In the Final Office Action, the Examiner states that paragraph 17 of *Roman* “explicitly states [that] the display offers replacement or exchange.” (Final Office Action, page 3). The Examiner relies upon the definition of “list” provided by Webster’s Collegiate Dictionary as supporting the Examiner’s conclusion that the “display of two options for returns is read as a list.” (Final Office Action, page 3). Even if offering the consumer an option of replacement or exchange is within the broad meaning of “list,” providing the consumer with a choice of return or exchange certainly is not analogous to Applicant’s recited step of “displaying, to the customer via the web access tool, the transaction information comprising **a list of the at least one item of merchandise.**” Similarly, a selection by a user of either “return” or “exchange,” as disclosed in *Roman*, is not analogous to Applicant’s recited step of “receiving a **selection of an item of merchandise from the list** from the customer via the web access tool,” as also recited in Claim 1. These elements are completely absent from the disclosure of *Roman*.

Furthermore, Applicant continues to submit that the additional disclosure of *Haseltine* does not cure the deficiencies identified in *Roman* above. For a discussion of the operation of the “distributed network of point-of-return affiliates who will accept the e-tailer’s returns on a walk-in basis in such associate’s brick-and-mortar store” (Page 2, paragraph 18), Applicant refers the Examiner to Applicant’s arguments in the previous Response to Office Action submitted on April 26, 2006. Specifically, Applicant demonstrated that **the point-of-return associate** of *Haseltine* obtains an electronic packing slip in response to processing (i.e., scanning) the inventive bar-coded packing slip. With respect to the electronic packing slip, *Haseltine* discloses that such a “bar-coded packing slip is affixed by any suitable means to as much of the product that comprises a discrete, returnable unit.” (Page 2, paragraph 26). For example, “if the discrete returnable unit is a garment, then preferably it is the garment to which the bar code is directly affixed.” (Page 2, paragraph 27). Thus, the bar-coded packing slip is item specific.

Haseltine describes the process for return of such a garment as follows:

The point-of-return associate 42 provides walk-in processing of the primary target’s request for return. The point-of-return associate reads or otherwise enters the immediate message given by the inventive bar-coded packing slip 26. Again, the immediate message might actually be a web request for the

download of the more full record of the packing slip. However gotten, the *point-of-return associate* calls up the electronic packing slip. Unlike most paper packing slips seen nowadays, this inventive electronic packing slip includes precise information if not instructions to the point-of-return associate. Such information or instructions will guide this point-of-return associate on how to properly authorize the return of the given product of this e-tailer.

(Page 3, paragraph 35). Accordingly, the item specific packing slip provides item specific “information or instructions that will guide **this point-of-return associate** on how to properly authorize the return of **the given product** of this e-tailer.” (Page 3, paragraph 35). As such, *Haseltine* does not disclose, teach, or suggest “displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise.” Furthermore, as the displayed information and instructions of *Haseltine* are item-specific, there is no reason that the system of *Haseltine* would include “receiving a selection of an item of merchandise from the list from the customer via the web access tool,” as also recited in Claim 1.

Finally, Applicant notes that each of the “displaying” and “receiving” steps recited in Applicant’s claims recite an operation relating in some manner to a “list of the at least one item of merchandise.” To the extent that the Examiner relies upon *Roman* for disclosure of the operational steps of “displaying, to the customer, via the web access tool, the transaction information” and “receiving a selection . . . from the list from the customer via the web access tool” but then relies upon *Haseltine* for disclosure of the “list of at least one item of merchandise,” Applicant respectfully traverses such a piece meal rejection of Applicant’s claim language. Applicant poses the question: How can *Roman* possibly disclose “displaying, to the customer via the web access tool, the transaction information comprising a list of the at least one item of merchandise” and “receiving a selection of an item of merchandise from the list,” as recited in Claim 1, if *Roman* does not disclose “the list of the at least one item of merchandise,” as recited in Claim 1? Even if *Haseltine* discloses the list of the at least one item of merchandise recited in Applicant’s Claim 1 (which Applicant does not admit and disputes above), such a piecemeal rejection of Applicant’s claim fails to give credence to each element of Appellant’s Claim 1 and to the overall combination of features recited in the claim. The M.P.E.P. provides that “[a]ll words in a claim must be considered in judging the

patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Applicant respectfully submits that a rejection of Claim 1 under the *Roman-Haseltine* combination, in the manner provided by the Examiner, can only result from the piecing together of disjointed portions of unrelated references to reconstruct Applicant's claims.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1.

Dependent Claims 2-5, 7-8, and 10-16 depend upon independent Claim 1 and are not obvious over the proposed *Roman-Haseltine* combination because they include the limitations of independent Claim 1 and recite additional elements that further distinguish the art. Since Claims 2-5, 7-8, and 10-16 incorporate the limitations of independent Claim 1, which Applicant has shown above to be allowable, Applicant has not provided detailed arguments with respect to Claims 2-5, 7-8, and 10-16. However, Applicant remains ready to do so if it becomes appropriate. For at least these reasons, Applicant respectfully requests reconsideration and allowance of dependent Claims 2-5, 7-8, and 10-16.

The Proposed *Roman-Haseltine* Combination is Improper

Assuming for purposes or argument that the proposed combination discloses the limitations of Applicant's claims (which Applicant disputes above), Applicant continues to submit that it would not have been obvious to one skilled in the art to make the proposed *Roman-Haseltine* combination.

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed above, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention. It is clear based at least on the many distinctions discussed above

that the proposed *Roman-Haseltine* combination does not, taken as a whole, suggest the claimed invention, taken as a whole. Applicant respectfully submits that the Examiner has merely pieced together disjointed portions of references, with the benefit of hindsight using Applicant's claims as a blueprint, in an attempt to reconstruct Applicant's claims.

The governing Federal Circuit case law makes this strict legal standard clear.¹ According to the Federal Circuit, "a showing of a suggestion, teaching, or motivation to combine or modify prior art references is an essential component of an obviousness holding." *In re Sang-Su Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed. Cir. 2000)). "Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). However, the "range of sources available . . . does not diminish the requirement for actual evidence." *Id.* ***Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so."*** *In re Mills*, 916 F.2d at 682, 16 U.S.P.Q.2d at 1432 (emphasis added). *See also In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (***holding a prima facie case of obviousness not made where the combination of the references taught every element of the claimed invention but did not provide a motivation to combine***); *In Re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1944 (Fed. Cir. 1992) ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at" the claimed invention.). Even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed modification or combination is not sufficient to establish a *prima facie* case of obviousness. *See In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

¹ Note M.P.E.P. 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, “*The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.*” M.P.E.P. § 2142 (emphasis added). The governing Federal Circuit cases are equally clear. “A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one ‘to fall victim to the insidious effect of a hindsight syndrome *wherein that which only the invention taught is used against its teacher.*’” *In re Kotzab*, 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted; emphasis added). In *In re Kotzab*, the court noted that to prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. *See id.* *See also, e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 U.S.P.Q.2d 1788, 1792 (Fed. Cir. 1988). Similarly, in *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board, *explaining that the required evidence of such a teaching, suggestion, or motivation is essential to avoid impermissible hindsight reconstruction of an applicant's invention:*

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is ***rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.*** Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999, 50 U.S.P.Q.2d at 1617 (emphasis added) (citations omitted; emphasis added).

In the Office Action, the Examiner speculates that "it would have been obvious to modify *Roman et al.* to include *Haseltine's* information access feature, the motivation being reducing the work required by the customer in remembering the details of the purchase." (Final Office Action, pages 3-4). It appears that the Examiner has merely proposed alleged an advantage of combining *Roman* with *Haseltine* (an advantage which Applicant does not admit could even be achieved by combining these references in the manner the Examiner proposes). The Examiner has not pointed to any portions of the cited references, however, that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to incorporate the database of the walk-in processing location disclosed in *Haseltine* with the web-based fraud detection system disclosed in *Roman*. In other words, the alleged advantage of "reducing the work required by the customer" does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention (*without using Applicant's claims as a guide*) to combine the very different systems disclosed in *Roman* and *Haseltine*; (2) how one of ordinary skill in the art at the time of Applicant's invention would have actually done so; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system. Of course, as the Federal Circuit has made clear and as discussed above, that is not the law.

Additionally, Applicant finds no reason in either *Roman* or *Haseltine* as to why one of ordinary skill in the art would be motivated to combine these two seemingly unrelated references in the manner proposed by the Examiner for the reasons proposed by the Examiner. *Roman* relates to an "intelligent Internet enabled reverse logistics processing system" that is used by the consumer "as the consumer prepares to return an item." (Page 1, paragraph 14). Specifically, the system of *Roman* provides suggestive up selling techniques such that "[w]hile the customer is processing a return, and before the transaction is complete, ClickReturns.com will immediately offer a similar replacement product for purchase or exchange from the originating retailer." (Page 2, paragraph 17). By contrast, the very

principle and purpose of the system disclosed in *Haseltine* is to provide “a distributed network of point-of-return affiliates who will accept the e-tailer’s returns on a walk-in basis in such associate’s brick-and-mortar store.” (Page 2, paragraph 18). Because the very systems and objectives of the *Roman* and *Haseltine* systems are very different from one another, Applicant respectfully submits that one of ordinary skill in the art at the time of invention would not have been motivated to modify *Roman* to include features of *Haseltine* in the manner proposed by the Examiner.

Indeed, the identified differences in *Roman* and *Haseltine* provide further evidence that one of ordinary skill in the art at the time of Applicant’s invention would have considered the references as relating to different fields of invention and would not made the proposed combination. Applicant respectfully submits that the Examiner’s attempt to modify or combine *Roman* with *Haseltine* appears to constitute the type of impermissible hindsight reconstruction of Applicant’s claims, using Applicant’s claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Roman* and *Haseltine* in the manner the Examiner proposes, Applicant respectfully submits that the Examiner’s conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Applicant respectfully submits that the rejection must therefore be withdrawn.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, together with Claims 2-8 and 10-16 that depend from Claim 1.


CONCLUSION

Applicant has made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests reconsideration and full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Jenni R. Moen, Attorney for Applicant, at the Examiner's convenience at (214) 953-6809.

Although no fees are believed due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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